AF
1209

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of **Einke et al**
Serial No.: **09/557,597**
Filed: **4/25/2000**
Title: **SYSTEM FOR PROVIDING PERSONALIZED SERVICES**

Atty. Docket No.: **PHN 17-430**
Group Art Unit: **2635**
Examiner: **Nguyen, Nam V**

Commissioner for Patents
Alexandria, VA 22313-1450

Sir:

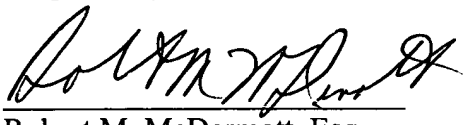
Enclosed is an original plus two copies of an Appeal Brief in the above-identified application.

[X] A credit card authorization in the amount of **$330** is enclosed.

[ ] The Commissioner has already been authorized to charge fees in this application to Deposit Account .

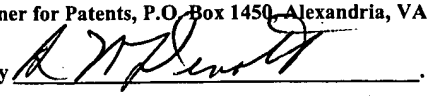
[ ]The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account _____. Enclosed is a copy of this sheet.

Respectfully submitted,



Robert M. McDermott, Esq.
Reg. No. 41,508
804-493-0707

CERTIFICATE OF MAILING
It is hereby certified that this correspondence is being deposited with the United States Postal Service as first-class mail in an envelope addressed to: Mail Stop Appeal Brief- Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450

On 27 July 2004 By  .

#18 Appeal Brief 8/12/04 (tw)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of **Einke et al**
Serial No.: **09/557,597**
Filed: **25-Apr-2000**
Title: **SYSTEM FOR PROVIDING PERSONALIZED SERVICES**

Atty. Docket No.: **PHN 17-430**
Group Art Unit: **2635**
Examiner: **Nguyen, Nam V**

APPELLANT'S BRIEF ON APPEAL UNDER 37 C.F.R. § 1.192

Commissioner for Patents
Alexandria, VA 22313-1450

Sir:

This is an appeal from the decision of the Examiner dated 2 April 2004, finally rejecting claims 1, 2, 4-10, and 13-18 of the subject application.

I. REAL PARTY IN INTEREST

The above-identified application is assigned, in its entirety, to U.S. Philips Corporation, a company organized under the laws of the State of Delaware.

II. RELATED APPEALS AND INTERFERENCES

Appellant is not aware of any co-pending appeal or interference which will directly affect or be directly affected by or have any bearing on the Board's decision in the pending appeal.

III. STATUS OF CLAIMS

Claims 1, 2, 4-10, and 13-18 are pending in the application. Claims 1 and 14 stand rejected under 35 U.S.C. 102(b), and claims 2, 4-10, 13, and 15-18 stand rejected under 35 U.S.C. 103(a).

IV. STATUS OF AMENDMENTS

No amendments were filed subsequent to the final rejection in the Office Action dated 2 April 2004.

V. SUMMARY OF THE INVENTION

The invention comprises a "gatekeeper" device that selectively transmits an identity tag to an apparatus to affect the subsequent operation of the apparatus. A user of the gatekeeper device sets the device to a state that controls the selective transmission of the identity tag. The user controls whether the gatekeeper device should be recognized by the apparatus, and to which extent the apparatus should adapt its behavior to the user. (Applicants' page 2, lines 10-18.) In a first example state, the gatekeeper device always responds to a probe signal from the apparatus. In a second example state, the gatekeeper device notifies the user of the probe signal, but does not respond until the user explicitly confirms that the response should be sent. In a third example state, the gatekeeper device does not notify the user of the probe signal, and does not respond. Other states, including permutations of these states, are also supported.

In an example embodiment of the invention, the gatekeeper device includes three buttons: red, orange, and green. When the device first receives the probe from an apparatus, it notifies the user, for example, by flashing or beeping. If the user presses the green button, the gatekeeper device is configured to transmit the identity tag immediately and automatically in the future when the apparatus is encountered. If the user presses the red button, the gatekeeper device is configured not to send the identity tag now or in the future to this apparatus, and not to notify the user of future probes from this apparatus. If the user presses the orange button, the gatekeeper device is configured to transmit the identity tag immediately, but not automatically in the future. (Applicants' page 4, line 10 through page 5, line 31.) The probe signal can be configured to identify a particular apparatus, a class of apparatuses, and so on, so that the gatekeeper device's selective transmission can be based on a specific or general identification of the apparatus (Applicants' page 2, lines 27-28).

By providing selective transmission of the identity tag, the user of the gatekeeper device is able to control the dissemination of the user's identity. For example, a user may configure the device to transmit the identity tag to all apparatuses in a familiar environment, such as the user's home or office, but not to transmit the identity tag without explicit authorization while the user is in a public environment, such as an airport terminal. Additionally, the user can configure the device to never transmit the identity tag

to designated apparatuses or classes of apparatuses. By controlling the dissemination of the identity tag, the likelihood of the tag being copied and subsequently used by another person for unauthorized purposes is minimized.

Upon receipt of the identity tag from the gatekeeper device, the apparatus adapts its behavior accordingly. The control of the apparatus based on the identity tag can be effected in a variety of ways. In an adaptive configuration, the apparatus modifies its behavior based on prior controls of the apparatus after receiving the identity tag. In another configuration, a user profile is explicitly created at the apparatus and associated with the identity tag; optionally, the identity tag may be created at the apparatus when the profile is created and communicated to the gatekeeper device for subsequent use with this apparatus. In another embodiment, the user profile is stored in the gatekeeper device and communicated to the apparatus.

VI. ISSUES

Are claims 1 and 14 patentable under 35 U.S.C. 102(b) over Duhame et al. (USP 5,541,585, hereinafter Duhame)?

Are claims 2, 6-10, 13, and 15-18 patentable under 35 U.S.C. 103(a) over Duhame and Nickum (USP 6,359,661)?

Is claim 4 patentable under 35 U.S.C. 103(a) over Duhame and D'Angelo et al. (USP 6,625,974, hereinafter D'Angelo)?

Is claim 5 patentable 35 U.S.C. 103(a) over Duhame, D'Angelo, and Kushiro et al. (USP 6,285,357, hereinafter Kushiro)?

VII. GROUPING OF CLAIMS

Claims 1, 2, 4, 10, 14, 15, and 17 stand or fall together; claim 5 stands alone; claims 6 and 16 stand or fall together; claim 7 stands alone; and claims 8, 9, and 18 stand or fall together.

VIII. ARGUMENT

Claim 5 stands alone because claim 5 includes the limitation that the apparatus identifies itself to the gatekeeper device, thereby enabling selective response from the gatekeeper based on the identification of the apparatus, which is a patentably distinct feature from the other claims. Claims 6 and 16 stand or fall together because each of these claims includes a gatekeeper device having selection options for controlling subsequent communications from the device, which is a patentably distinct feature from the other claims. Claim 7 stands alone because claim 7 includes a gatekeeper device that receives an identity tag from the controlled apparatus, which is a patentably distinct feature from the other claims. Claims 8, 9, and 18 stand or fall together because each of these claims includes a gatekeeper device that stores a user profile for controlling an apparatus, which is a patentably distinct feature from the other claims.

Are claims 1 and 14 patentable under 35 U.S.C. 102(b) over Duhame?

Each of claims 1 and 14 specifically recite a gatekeeper device that selectively transmits a user identification in response to a communication from an apparatus.

Duhame teaches a security system that uses a conventional RFID transceiver that communicates an identifier when it receives an interrogation signal from a fixed transceiver. Duhame does not teach ***selectively*** transmitting the identifier when it receives the interrogation signal. Duhame automatically transmits the identifier when it receives the interrogation signal. Of particular note, Duhame's RFID transceiver will automatically transmit the identifier when it receives a similar interrogation signal from any transmitter. This indiscriminate dissemination of the identifier allows the opportunity for someone to surreptitiously send an interrogation signal, receive the identifier, and program another RFID device with this identifier. This other RFID device can then be used to gain unauthorized access to the area protected by the security system, by merely responding to the security system's interrogation signal with this identifier.

The final Office action acknowledges the non-selective nature of Duhame's transmissions: "When portable transceiver 18 receives the interrogation signal from fixed transceiver 16, it automatically transmits the response signal, requiring no user

intervention. Thus it is not necessary to remove portable transceiver 18 from the purse or pocket." (Office action page 3, lines 9-12.)

As cited in MPEP 2131, "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Duhame teaches the automatic transmission of a response signal whereas the applicants teach and claim the selective transmission of a response signal. The applicants respectfully maintain that an automatic transmitter is not identical to a selective transmitter, and Duhame does not show the claimed selective-transmission feature.

Because Duhame fails to teach the selective transmission of an identification key in response to a communication from an apparatus, as specifically claimed by the applicants, the applicants respectfully maintain that claims 1 and 14 are patentable under 35 U.S.C. 102(b) over Duhame.

Are claims 2, 6-10, 13, and 15-18 patentable under 35 U.S.C. 103(a) over Duhame and Nickum?

Each of the applicants' independent claims 1, 8, 10, and 14 includes the selective transmission of an identifier in response to a communication from a controllable apparatus.

As stated in MPEP 2142: "To establish a *prima facie* case of obviousness ... the prior art reference (or references when combined) must teach or suggest all the claim limitations."

The final Office action relies upon Duhame for teaching the claimed limitation of selectively transmitting an identifier in response to a communication from a controllable apparatus. As noted above, however, the final Office action acknowledges that Duhame teaches "When portable transceiver 18 receives the interrogation signal from fixed transceiver 16, it automatically transmits the response signal" (Office action, page 3, lines 9-11).

The applicants respectfully maintain that a device that automatically transmits a response signal in response to a communication cannot be said to selectively transmit a response signal in response to a communication, as specifically claimed in each of the

applicants' independent claims, and thus the final Office action fails to establish a *prima facie* case of obviousness by the absence of this claimed limitation.

Because the rejection of claims 2, 6-10, 13, and 15-18 is premised on the assertion that Duhame teaches a selective transmission, and because the Office action acknowledges that Duhame teaches an automatic transmission, the applicants respectfully maintain that claims 2, 6-10, 13, and 15-18 are patentable under 35 U.S.C. 103(a) over Duhame and Nickum.

Further, with regard to claims 2, 6, 10, 15, and 16, the applicants claim a gatekeeper device that includes a user control to selectively transmit the user identification in claims 2, 10, and 15, and one or more options that affect selective transmissions at subsequent occasions in claims 6 and 16.

The Office action relies upon Nickum for teaching a gatekeeper device that includes a user control to selectively transmit the user identification, and options that affect selective transmissions at subsequent occasions. The applicants respectfully disagree with this characterization of Nickum.

Nickum teaches a remote control device that controls access to television programs, to facilitate, for example, parental control of the channels that a child is permitted to view. A default set of allowable programs are defined, and sets of controlled programs are defined, each set having an associated user ID. In order for a user of the remote control device to effect a change of channel to any channel other than one of the allowable programs, the user must input a user ID. The input ID is compared to the stored set of user IDs in the remote device to determine the set of controlled programs that the user is permitted to view.

Nickum teaches that when the user presses the "ID" function key, the remote control device executes the flow illustrated in FIG. 4. As illustrated in FIG. 4, the ID function key causes the remote device to check whether the input ID matches either a "master control" ID, at 414, or a stored user ID, at 420. Thereafter, the control of sending the requested program change command is effected, at 450 and 460. The signal that is transmitted to the television receiver, at 480, is the program-change signal, if the requested program is authorized for viewing based on the user ID.

Nickum does teach that the above described control can be stored in circuitry within the television. In such an embodiment, however, Nickum specifically teaches: "Each remote control device has ... an individualized identifying signal incorporated in the conventional circuitry. Each user selection is then accompanied by the identifying signal, which is translated by the circuitry in the television ... to reference the proper user profile and assigned viewing restrictions.

That is, when the control circuitry is located in the television, Nickum's remote control device always sends the identifying signal with each user selection. In this embodiment, the user has no control over whether the identifying signal is sent to the television. When the control circuitry is located within Nickum's remote control device, the identifying signal is not sent to the television.

The applicants respectfully maintain that Nickum's device does not include a user control to selectively transmit the user identification, as specifically claimed in each of claims 2, 10, and 15, and thus the final Office action fails to establish a *prima facie* case of obviousness. Because of the absence of this claimed limitation in the prior art, the applicants respectfully maintain that claims 2, 10, and 15 are patentable under 35 U.S.C. 103(a) over Duhame and Nickum.

The applicants further maintain that Nickum's device does not include an option to affect selectively transmitting the user identification at subsequent occasions, as specifically claimed in each of claims 6 and 16, and thus the final Office action fails to establish a *prima facie* case of obviousness. Because of the absence of this claimed limitation in the prior art, the applicants respectfully maintain that claims 6 and 16 are patentable under 35 U.S.C. 103(a) over Duhame and Nickum.

With regard to claim 7, the applicants claim an apparatus that generates an identity tag and communicates it to the gatekeeper device for use as the user identification at subsequent occasions.

The final Office action asserts that Nickum teaches an apparatus that generates an identity tag and communicates it to the gatekeeper device for use as the user identification at subsequent occasions at column 5, lines 42-59. The applicants respectfully note that the referenced text of Nickum is silent with regard to generating an

identity tag at the apparatus/television, and is silent with regard to any communications from the television to the Nickum's remote control device.

The applicants respectfully maintain that Nickum does not disclose an apparatus that generates an identity tag and communicates it to the gatekeeper device for use as the user identification at subsequent occasions, as specifically claimed in claim 7, and thus the final Office action fails to establish a *prima facie* case of obviousness. Because of the absence of this claimed limitation in the prior art, the applicants respectfully maintain that claim 7 is patentable under 35 U.S.C. 103(a) over Duhame and Nickum.

In claims 8, 9, and 18, the applicants claim an apparatus that modifies its behavior based on a user profile, and a gatekeeper device that stores the user profile for communication to the apparatus.

Nickum teaches either a remote control device that transmits commands to a television, with selective blocking of the transmission of certain channel-changing commands, based on a user profile stored at the remote control device, or a controller at the television with selective blocking of commands received from a remote control device, based on a user profile stored at the television. (Nickum column 8, lines 34-36.)

The applicants respectfully maintain that Nickum does not disclose storing the user profile in a gatekeeper device for subsequent communication to the controlled apparatus, as specifically claimed in each of claims 8, 9, and 18, and thus the final Office action fails to establish a *prima facie* case of obviousness. Because of the absence of this claimed limitation in the prior art, the applicants respectfully maintain that claims 8, 9, and 18 are patentable under 35 U.S.C. 103(a) over Duhame and Nickum.

Is claim 4 patentable under 35 U.S.C. 103(a) over Duhame and D'Angelo?

Claim 4 specifically claims a gatekeeper device that selectively transmits a user identification in response to a communication from an apparatus, and provides a notification of the communication from the apparatus.

The Office action relies upon Duhame for teaching a gatekeeper device that selectively transmits a user identification in response to a communication from an

apparatus, and D'Angelo for teaching providing a notification of the communication from the apparatus. The applicants concur that D'Angelo teaches a notification device.

As discussed above, the final Office action relies upon Duhame for teaching the claimed limitation of selectively transmitting an identifier in response to a communication from a controllable apparatus. However, the final Office action acknowledges that Duhame teaches "When portable transceiver 18 receives the interrogation signal from fixed transceiver 16, it automatically transmits the response signal" (Office action, page 3, lines 9-11).

The applicants respectfully maintain that a device that automatically transmits a response signal in response to a communication cannot be said to selectively transmit a response signal in response to a communication, as specifically claimed in independent claim 1, upon which claim 4 depends, and thus the final Office action fails to establish a *prima facie* case of obviousness by the absence of this claimed limitation.

Because the rejection of claim 4 is premised on the assertion that Duhame teaches a selective transmission, and because the Office action acknowledges that Duhame teaches an automatic transmission, the applicants respectfully maintain that claim 4 is patentable under 35 U.S.C. 103(a) over Duhame and D'Angelo.

Is claim 5 patentable 35 U.S.C. 103(a) over Duhame, D'Angelo, and Kushiro?

Claim 5 claims a gatekeeper device that selectively transmits a user identification in response to a communication from an apparatus, and provides a notification of the communication from the apparatus, wherein the communication from the apparatus includes an identification of the apparatus.

The Office action relies upon Duhame for teaching a gatekeeper device that selectively transmits a user identification in response to a communication from an apparatus, D'Angelo for teaching providing a notification of the communication from the apparatus, and Kushiro for teaching a communication from an apparatus that identifies the apparatus. The applicants concur that D'Angelo teaches a notification device, and that Kushiro teaches an apparatus identifying signal.

As discussed above, the final Office action relies upon Duhame for teaching the claimed limitation of selectively transmitting an identifier in response to a communication from a controllable apparatus. However, the final Office action acknowledges that Duhame teaches "When portable transceiver 18 receives the interrogation signal from fixed transceiver 16, it automatically transmits the response signal" (Office action, page 3, lines 9-11).

The applicants respectfully maintain that a device that automatically transmits a response signal in response to a communication cannot be said to selectively transmit a response signal in response to a communication, as specifically claimed in independent claim 1, upon which claim 4 depends, and thus the final Office action fails to establish a *prima facie* case of obviousness by the absence of this claimed limitation.

Because the rejection of claim 5 is premised on the assertion that Duhame teaches a selective transmission, and because the Office action acknowledges that Duhame teaches an automatic transmission, the applicants respectfully maintain that claim 5 is patentable under 35 U.S.C. 103(a) over Duhame, D'Angelo, and Kushiro.

Further, the applicants disagree with the combination of Kushiro and Duhame. In Duhame, the remote device always transmits an identifying signal upon receipt of a communication from a controllable apparatus. Kushiro teaches controllable apparatuses that each transmit a unique code, so that a remote control can be configured to control the selected apparatus.

The final Office action asserts that the motivation for combining Duhame and Kushiro "would have been to provide a portable transceiver able to operate and control a plurality of appliances in order to minimize the confusion of which appliance is controlled at the present". The applicants respectfully disagree with this assertion.

Duhame teaches a remote device that only sends an identification signal. Any and all control that is enabled in Duhame by sending the identification signal is embodied in the controlled apparatus, based on information associated with this identification signal. Because Duhame's device always responds with the identification signal, there is no apparent need in Duhame to distinguish among the variety of apparatuses that receive this identification signal, because in Duhame there is no "confusion of which appliance is

controlled at the present", as asserted in the Office action as the motivation for combining Duhame and Kushiro.

The applicants respectfully maintain that a need for an apparatus identifier is only present if the transmission of the user identification to the apparatus is selective, as taught by the applicants, and Duhame does not teach a selective transmission of the user identification.

Because the stated motivation for combining Duhame and Kushiro is premised on an unfounded assertion, the applicants respectfully traverse the combination of Duhame and Kushiro.

CONCLUSIONS

Because Duhame does not teach the selective transmission of a user identification in response to a communication from an apparatus that modifies its behavior based on the user identification, as specifically claimed in each of the applicants' independent claims, the Applicant respectfully requests that the Examiner's rejection of claims 1 and 14 under 35 U.S.C. 102(b), and claims 2, 4-10, 13, and 15-18 under 35 U.S.C. 103(a) be reversed by the Board, and the claims be allowed to pass to issue.

Further, because Nickum does not teach or suggest a user control to selectively transmit the user identification, as specifically claimed in each of claims 2, 10, and 15, and does not teach an option to affect selectively transmitting the user identification at subsequent occasions, as specifically claimed in each of claims 6 and 16, and does not teach an apparatus that generates an identity tag and communicates it to the gatekeeper device for use as the user identification at subsequent occasions, as specifically claimed in claim 7, and does not teach storing a user profile in a gatekeeper device for subsequent communication to the controlled apparatus, as specifically claimed in each of claims 8, 9, and 18, the applicants respectfully request that the Examiner's rejection of claims 2, 6-10, 13, and 15-18 under 35 U.S.C. 103(a) over Duhame and Nickum be reversed by the Board, and the claims be allowed to pass to issue.

Respectfully submitted,

Robert M. McDermott, Attorney
Registration Number 41,508

APPENDIX
CLAIMS ON APPEAL

1. A system for providing personalized services, comprising

an apparatus which is capable of personalizing its behavior in accordance with a user profile, and

a gatekeeper device that is configured to selectively transmit a user identification only, in response to receipt of a communication from the apparatus,

wherein

the apparatus is configured to effect the personalizing of its behavior based on the user identification

2. A system as claimed in Claim 1, characterized in that

the gatekeeper device includes a user control to selectively transmit the user identification.

3. (Cancelled)

4. A system as claimed in Claim 1, characterized in that

the gatekeeper device is configured to provide notification of the communication from the apparatus.

5. A system as claimed in claim 4, characterized in that

the communication from the apparatus includes an identification signal of the apparatus that distinguishes the apparatus from an other apparatus.

6. A system as claimed in claim 1, characterized in that

the gatekeeper device is further configured to enable selection of one or more options that affect selectively transmitting the user identification at subsequent occasions.

7. A system as claimed in Claim 1, characterized in that

the apparatus is further configured to:

generate an identity tag which identifies a select personalization, and

communicate the identity tag to the gatekeeper device, the gatekeeper device being capable of storing said identity tag for use as the user identification at subsequent occasions.

8. A system for providing personalized services, comprising

an apparatus which is capable of personalizing its behavior in accordance with a user profile, and

a gatekeeper device that is configured to selectively transmit a user identification, in response to receipt of a communication from the apparatus,

wherein

the apparatus is configured to effect the personalizing of its behavior based on the user identification and a user profile, and

the gatekeeper device is capable of storing the user profile for selective communication to the apparatus.

9. A system as claimed in Claim 8, characterized in that the apparatus is capable of exchanging the user profile with the gatekeeper device or another apparatus.

10. A gatekeeper device comprising:

a transceiver that is configured to:

receive communication from an apparatus that is configured to effect a personalization of the operation of the apparatus based on a user identification, and

selectively transmit the user identification only; and

one or more user controls that facilitate selectively transmitting the user identification.

11-12. (Cancelled)

13. A system as claimed in Claim 1, characterized in that

the apparatus is further configured to effect the personalizing of its behavior based on user behavior following a prior receipt of the user identification.

14. A method of facilitating personalization of a plurality of apparatuses, comprising

receiving a communication from each apparatus of the plurality of apparatuses, and

selectively communicating a user identification to each apparatus, in response to the communication from each apparatus, to selectively effect a personalization of each apparatus of the plurality of apparatuses based on the user identification.

15. The method of claim 14, wherein

selectively communicating includes receiving a user selection that effects a transmission of the user identification.

16. The method of claim 15, wherein

the user selection also controls future transmission of the user identification to each apparatus.

17. The method of claim 14, wherein

the personalization of each apparatus is further based on user behavior following a prior communication of the user identification.

18. A system as claimed in Claim 8, characterized in that the gatekeeper device is capable of exchanging the user profile with a plurality of other apparatuses.